



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/735,446	12/13/2000	Thomas P. Murphy	56945.000004	7890

7590 09/02/2003
Kevin T. Duncan, Esq.
Hunton & Williams
Suite 1200
1900 K Street, N.W.
Washington, DC 20006

EXAMINER

CARLSON, JEFFREY D

ART UNIT PAPER NUMBER

3622

DATE MAILED: 09/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/735,446

Applicant(s)

MURPHY ET AL.

Examiner

Jeffrey D. Carlson

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4, 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:

- There is no brief description for figure 59.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- ? ■ Claim 1 line 17, there is no antecedent basis for "the parameters."
- ✓ ■ Claim 7 page 62 line 1, there is no antecedent basis for "the user."

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kepecs (US6330543) in view of Walker et al ('207) (US5794207).

Regarding claim 1, 2, 5, 8, 11, 23, 24, Kepecs teaches a centralized host which provides an online promotion (incentive) system. Users remotely register/log in and browse offers that are targeted to them. A user may "select" an offer online and then "redeem" the offer at a retail location which may include a discount at the time of purchase [2:23-34, 5:18-60, 11:4-30]. The communication from the central host to the POS detailing the qualification for discount/offer is taken to be disbursement of a redeemable electronic certificate. Kepecs does not teach details for user fees. Official Notice is taken that it is well known to charge users for services and to refund fees if the users follow through and make purchases. It would have been obvious to one of ordinary skill at the time of the invention to have charged users a fee to their authorized credit card or other financial account associated with the targeted offering of promotions and to have waived or refunded fees if the users make purchases using the system. Kepecs teaches that the system can automatically "compute discounts" based on customer and product information. Formulas control system feedback and automatically modify promotions based on customer behavior [14:13-21]. Kepecs does not however teach customers suggesting prices or offer parameters. Walker et al ('207) however teaches a centralized, online system where users are allowed to submit offers to the system with customized, user-defined offer parameters. The system evaluates the user offers and either accepts or denies them. It would have been obvious to one of ordinary skill at the time of the invention to have provided the customized promotion

Art Unit: 3622

system of Kepecs with the ability for user-defined offer parameters, so that users can take advantage of more appealing customized promotions.

Regarding claim 3, 9, Kepecs teaches the use of a user printing a targeted coupon and presenting it at the retail location [1:48-51].

Regarding claim 4, 10, Kepecs teaches user registration/identification including name, address and email address [4:42-46, 3:6-7].

Regarding claim 6, 12, 25, Kepecs teaches manufacturers providing the promotions as well as funding them in the hopes of increased sales. It would have been obvious to one of ordinary skill at the time of the invention to have provided the system of Kepecs for promoting the sales of any type of good or service, including vehicles.

Regarding claim 7, 13, 15, 16, 17, Kepecs teaches that the identified user's profile is used to determine the offers for which the user qualifies (offers are targeted, individualized discounts determined through comparison/matching of users and offers) [6:63-68]. Kepecs also teaches keeping track of the user's online history including offer selection and even offer viewing [3:9-18].

Regarding claim 14, 19-22, Walker et al ('207) teaches that the system can process the user defined offer and return a modified offer (counter-offer) [22:39-43].

Regarding claim 18, 26-28, Kepecs teaches the use of a remote user graphical user interface (GUI) [11:8-10].

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Walker et al (US6041308) teaches a system for buyers to submit offers for products/services. Users are compensated if their offers are not accepted.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 703-308-3402. The examiner can normally be reached on Mon-Fri 8:30-6p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.



Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc